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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,081	01/08/2001	Michael T. Rossi	A7842	5137

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EXAMINER

KNAUSS, SCOTT A

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/755,081

Applicant(s)

ROSSI, MICHAEL T.

Examin r

Scott A Knauss

Art Unit

2874

-- The MAILING DATE f this communication appears on the c ver sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25 and 31-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25 and 31-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 3/11/03 has been entered and considered by the examiner.
The previous rejection is withdrawn, and the following new rejection is applied.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-25 and 31-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,809,194 (Lovie) in view of US 5,703,983 (Beasley, Jr) (both previously cited by the examiner).

Regarding claims 31,38,39, and 51, Lovie discloses in fig. 1 a fiber optic cable comprising:

An outer jacket #34

A plurality of optical fibers within the jacket

Regarding claims 20,32,39 and 45 Lovie discloses:

A binder #22 positioned between the fibers and the jacket, the binder inherently comprising a flexible material wrapped around the cable.

Lovie also discloses in fig. 5 the use of a plurality of physically detectable markings #62 at regular intervals along the cable core, which are detected by an automated detection system (consisting of a sensor #90 and a controller #94) during manufacture of the cable (fig. 5 discloses placing on outer jacket #99 on a cable)

Lovie also discloses that the marking can be made *anywhere* on the cable core (col. 6, lines 21-26), but does not explicitly state that the physically detectable marking is positioned on or within the flexible material of the binder.

Beasley, on the other hand discloses that binder markings (col. 4, lines 30-31) can be used to indicate transition points on a cable core (col. 3, lines 28-34). Such markings would inherently be considered to be *both* on *and* within the flexible material, because the markings themselves would become flexible parts of the cable binder

Therefore it would have been obvious to one of ordinary skill in the art to use known cable core markings, in this case binder markings as taught by Beasley, in the cable of Lovie, for the purpose of providing detectable markings to be detected in the system of fig. 5 of Lovie.

Regarding claims 20,32,39 and 45, the applicant is claiming the product including the process of making an optical cable, and therefore are of "product-by-process" nature. The courts have been holding for quite some time that: the determination of the patentability of product-process claim is based on the product itself rather than on the process by which the product is made. In re Thrope, 777 F. 2d 695, 227 USPQ 964 (Fed. Cir. 1985); and patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. Applicant has chosen to claim the invention in the product form. Thus, a prior art product which possesses the claimed product characteristics can anticipate or render obvious the claimed subject matter regardless of the manner in which it is fabricated. A rejection based on 35 U.S.C. section 102 or

alternatively on 35 U.S.C. section 103 of the status is eminently fail and acceptable. In re Brown and Saffer, 173 USPQ 685 and 688; In re Pilkington, 162 USPQ 147.

As such, no weight is given to the process steps recited in claims 20,32,39 and 45 i.e., "wherein the physically detectable feature is detected by an automated detection system during installation of the binder" or "wherein the plurality of physically detectable features are detected by an automated detection system during manufacture of said cable", and the claims are rejected over Lovie over Beasley as set forth above, since Lovie, as modified by Beasley, discloses a binder comprising a flexible material and a physically detectable feature on or within the flexible material, and the use of the same within an optical fiber cable.

Regarding claims 21,33,40 and 46, Lovie, as modified, discloses in fig. 5 markings placed at regular intervals on the cable core, thus, if the markings are binder markings as taught by Beasley, they would be repeated at regular intervals along the binder.

Regarding claims 22-25,34-37,41-44 and 47-50, Lovie discloses in col. 6, lines 21-26 the use of a detectable (identifiable) marking (claims 25,37,44 and 50) which may be fluorescent or luminescent, (claims 22,34,41 and 47), (and thus colored, claims 23,35,42 and 48) or magnetic (claims 24,36,43 and 49).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,293,081 (Grulick et al) and US 6,314,713 (Fitz et al) disclose additional methods of marking cables using automated systems.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Knauss whose telephone number is (703) 305-5043. The examiner can normally be reached on 9-6 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308 - 4819. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Art Unit: 2874

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

Scott Knauss

Art Unit 2874

sak
April 28, 2003



HEMANG SANGHAVI
PRIMARY EXAMINER